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CENTRAL FAX CENTER****MAR 15 2007**Atty Dkt. No.: 10030636-1
USSN: 10/729,606**REMARKS**

In view of the following remarks, the Examiner is requested to allow Claims 1-17, 19-24,27 and 30-37, the only claims pending and under examination in this application.

Claims 34 and 35 have been amended to clarify the claim language. Accordingly, no new matter has been added.

As no new matter has been added by way of these amendments, entry thereof by the Examiner is respectfully requested.

Objections to the Claims

Claims 34 and 35 have been objected to by the Examiner due to typographical errors, which Applicants have corrected by amendment. As such, this objection may be withdrawn.

Claim Rejections - 35 U.S.C. § 112, second paragraph

Claims 1-17, 19 and 31-37 have been rejected under 35 U.S.C. § 112, second paragraph. The Office asserts that it cannot be determined whether the recited "flexure" element is referring to a separate element or characterizing the behavior of a structural element (as a flexure property).

Courts have held that the test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

Atty Dkt. No.: 10030636-1
USSN: 10/729,606

In the present case, one of skill in the art would find the present claim terminology clear and definite when read in light of the specification. As claimed, the flexure or spring element is a distinct element from the base, cover and clamping members, but it interacts with the clamping member. This interpretation is in accordance with the teachings of the specification, for instance, paragraph [118] wherein it is stated that embodiments of the invention include a flexure array assay device wherein the "flexure may be integral to an array assay device or may be a separate piece or more than one separate pieces." Therefore, the Applicants contend that in view of the teachings of the specification, one of skill in the art would readily understand that the flexure element recited in the rejected claims is referring to a separate structural element and is not merely the characterization of a structural element. Consequently, the Applicants respectfully request that this rejection be withdrawn.

Further, the Office asserts that use of the term "when" in the claims renders the claim language unclear because the term "when" represents conditional language that is based on a possible event. Specifically, the Office appears to be asserting that recitation of the term "when" renders the claims *per se* indefinite because it references a future event.

The federal Circuit has held that the "requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles.... Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." See *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

Thus, the Applicants contend that there is no *per se* prohibition within 35 U.S.C. § 112, second paragraph, against referencing a future event in the language of a claim.

Atty Dkt. No.: 10030636-1
USSN: 10/729,606

Rather, the test for meeting the requirements of 35 U.S.C. § 112, second paragraph, is simply whether one of ordinary skill in the art would discern what is meant by the claim language when construed according to correct principles.

In the present case, one of skill in the art when interpreting the language of the claims in light of the teachings of the specification (e.g., paragraphs 62 and 63), would clearly understand the language of the claims to mean that when an array assembly and backing element are present in the claimed device, and when the clamping member is actuated, a force is applied to the cover and base in a manner sufficient to produce a uniform distance between the array assembly and the backing element. Simply because the array assembly and backing element are not positively recited in the claim language and/or because the claim describes how various elements of the claim interact when actuated does not prevent one of skill in the art from reasonably construing the meaning of the claim language. Hence, the claims as written are not so insolubly ambiguous that they are without a discernible meaning. As such, the meaning of the language of the claims is clear and definite.

For the above reasons, Claims 1-17, 19 and 31-37 are not indefinite under 35 U.S.C. § 112, second paragraph and this rejection may be withdrawn.

Claim Rejections - 35 U.S.C. § 102

Claims 1-8, 14-17, 19 and 31-33 remain rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Freeman (USPN 5,958,760).

In maintaining this rejection, the Office asserts that since the Freeman device includes the same elements as recited in the Applicants' claims, these elements are capable of interacting in the same manner to produce the same result as that of the Applicants' claimed device. Hence, the Office concludes that the Freeman device anticipates the Applicants' claimed invention. The rejection of the Office is, therefore, premised upon two grounds: that the Freeman device includes the same elements as recited in the Applicants' claims, and that these elements are capable of interacting in the same manner to produce the same result.

Atty Dkt. No.: 10030636-1
USSN: 10/729,606

The Applicants, however, respectfully disagree. In sustaining this rejection the Office appears to not have given patentable weight to the recited spring or flexure element. Specifically, an element of the rejected claims is a flexure or spring element. The flexure or spring element interacts with the clamping member such that when the clamping member is actuated a force is applied to the cover and base in a manner sufficient to produce a substantially uniform distance between an array assembly and backing element along the entire length of the cover and base when an array assembly and backing element are present in the device.

The Office has not set forth where in Freeman the recited flexure or spring element is taught. Rather, the Office assumes that simply because the Freeman device includes a base, a cover, a clamping member and a spring element that Freeman anticipates the Applicants claims. Essentially, the Office is equating the spring elements disclosed in Freeman with the flexure or spring element as recited in the Applicants claims.

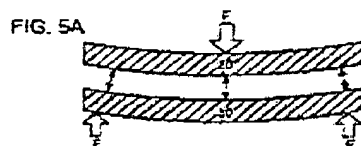
The Applicants respectfully disagree and contend that the spring elements recited in Freeman are not equivalent to the flexure or spring element recited in the Applicants claims because the spring elements in Freeman do not interact with a clamping member such that when the clamping member is actuated a force is applied to a cover and a base in a manner sufficient to produce a substantially uniform distance along the entire cover and base. Thus, for this reason alone this rejection may be withdrawn.

Additionally, the Office erroneously assumes that simply because Freeman may disclose all the elements recited in the Applicants claims that the Freeman device inherently anticipates the Applicants' claimed invention. The Applicants respectfully disagree and contend that the elements of the claimed assay device interact with one another in a manner sufficient to produce a substantially uniform distance along the entire cover and base. Specifically, the flexure or spring element interacts with the clamping member such that when the clamping member is actuated a force is applied to the cover and base in a manner sufficient to produce a

Atty Dkt. No.: 10030636-1
 USSN: 10/729,606

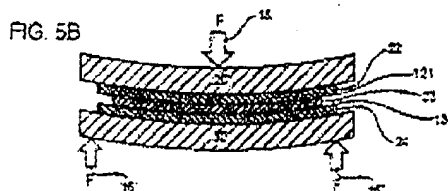
substantially uniform distance between an array assembly and backing element along the entire length of the cover and base when the array assembly and backing element are present in said device. As is described in detail below, the elements of the Freeman device are not capable of interacting in this manner. As such the Freeman device does not inherently anticipate the Applicants' claimed invention.

Specifically, a representative interaction between the flexure or spring element and the clamping member recited in the Applicants' claims is described in the Applicants' specification with reference to FIG. 5A, below:



As can be seen with reference to the above figure, and as described in the Applicants' specification (e.g., paragraph 94), the claimed assay device includes a flexure or spring element that interacts with the clamping member such that when the clamping member is actuated, a force is applied to the cover and base in a manner sufficient to produce a substantially uniform distance between the cover and base.

Further, when an array assembly and backing element are present in the device, and the clamping member is actuated, a force is applied to the cover and base in a manner sufficient to produce a substantially uniform distance between the array assembly and backing element along the entire length of the cover and base. A representative illustration of this interaction is set forth in FIG. 5B, below.



Atty Dkt. No.: 10030636-1
 USSN: 10/729,606

Hence, as can be seen with reference to the above figures, in each embodiment, the flexure or spring element is such that when the clamping member is actuated, the cover (20) and the base (30) are urged in substantially the same direction such that a substantially uniform distance is provided between the cover and the base (See FIG. 5A) and between the backing element and the array assembly, when present in the device (See FIG. 5B).

The Office asserts that the device disclosed in Freeman inherently functions to produce such a uniform distance between the array assembly and the backing element, which uniform distance is along the entire cover and base.

The Applicants, however, respectfully disagree. The device disclosed in Freeman is set forth in Fig 13a, below:

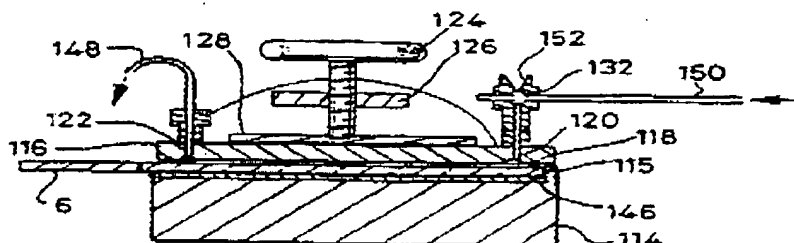


Fig. 13a

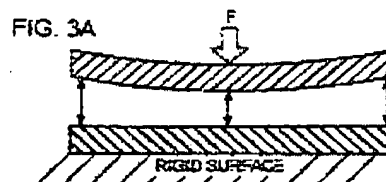
The apparatus of Fig 13a includes a support holding member 114 (e.g., a base), a clamping plate 128 (e.g., a cover), a screw threaded clamping member 124 (e.g., a clamping member), a support retaining member 116 (e.g., "array assembly"), and a support 6 (e.g., "backing element"). As can be seen with reference to the figure above, the clamping member 124 only contacts the clamping plate 128. The clamping plate 128 only contacts the retaining member 122 along a portion of the retaining member 122, it does not contact the retaining member along the entire length of the retaining member.

Hence, because the clamping plate 128 only contacts the retaining member 122 in a central portion of the retaining member 122, one of skill in the art would

Atty Dkt. No.: 10030636-1
USSN: 10/729,606

expect that a uniform distance between the retaining member 122 and the support 116 or base 114 is not produced along the entire length of the retaining member and base. One of skill in the art would expect this because, as explained in the Applicant's specification at paragraph 91, the distance between an opposing base and cover will be smallest at the region nearest the area where a force is applied and greater at distances further away from this region.

Thus, if the Freeman device were used as an array assay device, one would expect the distance between the cover and base to be non-uniform, as described in the Applicants' specification with reference to FIG. 3a, below:



Given the configuration of the Freeman device, one of skill in the art would expect that upon actuation of the clamping member, the clamping plate will produce a greater force on the central portion of the retaining member, where the clamping plate contacts the retaining member and less of a force on the edges of the retaining member where the clamping plate does not contact the retaining member. See FIG. 3A above. Thus, the distance between the retaining member and the support and/or base will be smaller in the central portion and greater toward the edges.

Therefore, the elements of the Freeman device are not capable of interacting in the same manner to produce the same result as the elements recited in the Applicants claims and consequently the assumption of the Office is erroneous and the Freeman device does not anticipate the Applicants' claimed invention.

In view of the above, the Applicants contend that Freeman does not anticipate the rejected claims because Freeman does not teach all the elements of the rejected claims and because the rejection of the Office is premised on erroneous

Atty Dkt. No.: 10030636-1
USSN: 10/729,606

assumptions. The Applicants, therefore, respectfully request that this rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 9-17, 19 and 31-37 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shea et al. (US Publication No. 2003/0235906).

With respect to Shea being available as prior art under 35 U.S.C § 103, 35 U.S.C. 103(c)(1) reads:

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The Shea patent and the instant application were owned by the same person or subject to an obligation of assignment to the same person, at the time the instant application was made.

The invention claimed in the instant patent application was subject to an obligation of assignment to Agilent Technologies. An assignment executed by the inventors to Agilent was recorded on March 20, 2006 (Reel/Frame 017334/0696).

The Shea patent cited as art was owned by Agilent Technologies at the time the claimed invention in that patent was made, as evidenced by an assignment by the listed inventors to Agilent Technologies, recorded on December 2, 2002 (Reel/Frame 013274/0656).

As can be seen in view of these two assignments, the subject matter of the cited Shea patent and the presently claimed invention were, at the time the invention

Atty Dkt. No.: 10030636-1
USSN: 10/729,606

was made, both owned by Agilent and/or both under an obligation of assignment to Agilent. As such, in accordance with §103(c)(1), the Shea patent shall not preclude patentability under §103.

Therefore, the Shea patent is not available as prior art against the claimed invention of the present application under §102 (e). The claims thus cannot be rejected under § 103 (a) by a rejection that relies upon the disclosure of Shea.

Accordingly, the Applicants respectfully request the rejection of Claims 1, 9-17, 19 and 31-37 under 35 U.S.C. § 103 (a) as being obvious over Shea be withdrawn.

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Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650)833-7770.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10030636-1.

Respectfully submitted,

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Registration No. 53,393Date: March 15, 2007By: Bret E. Field
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